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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,375	10/25/2001	Todd Fischer	10012680-1	2870

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,375

Applicant(s)

FISCHER, TODD

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1, 2, 4-13, and 15-19 have been examined.

Response to Arguments

2. Examiner has applied a new 112 rejection to Applicant's claim 1. Specifically, the rejection is directed to a lack an antecedent basis matter regarding the use of the term "the printer" in line 2. Applicant recites "a printing device configured to print information". To one of ordinary skill, such a device can be a computer configured to send a print instruction to another device such as a printer for printing information. And while, Applicant discloses both embodiments (a computer connected a printer and a printer with a remote print system therein— Specification, figure 2; page 7, lines 4-7) it is done mutually exclusively, hence there is insufficient antecedent basis for the term "the printer".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldy, U.S. Patent No. 5,956,406 in view of Choudhury et al., U.S. Patent No. 5,509,074.

As per claims 1, 2, 4-13, and 15-19, Maldy discloses a method and system for enabling secure communications between two users, devices and/or systems. Specifically, Maldy discloses public/private key cryptography where a receiver generates a key pair. A first (public) key is sent to a sender for encrypting a message intended for the receiver. The sender encrypts the message using the first key then sends the encrypted message to the receiver who decrypts it using the second (private or secret) key (column 1, lines 11-47). Regarding the displaying of the public key, the Examiner takes Official Notice that the displaying of public keys is old and well-known. Maldy, however, does not specifically recite using cryptography to secure communications between a printer and server (e.g. data encryption/retrieval system). Therefore, in view of the clear teachings of Maldy and what it would have rendered obvious to one of ordinary skill, the patentability of Applicant's claims then rests on whether there is a prior art teaching that explicitly recites or at least suggests a need for the confidential communication of data between a remote print system (i.e. printer) and a data encryption/retrieval system, such as a server. Choudhury et al. teach

a method and system for sending a message (i.e. content) from a server to a printer (figures 1 and 2). More specifically, Choudhury et al. teach a user at a request system communicating with a data encryption/retrieval system (figure 4) for requesting the message be sent with the intent of the user printing the message (column/line 3/66-4/21), where the message is encrypted using a cryptographic protocol (column 4, lines 21-35). Regarding portability, it has been held that an obvious modification to the request system (figure 4) of Choudhury et al. would have been to make it portable (*In re Lindberg*, 194 F.2d 732, 735, 93 USPQ 23, 26 (CCPA); *Ranco, Inc. v. Gwynn et al.*, 128 F.2d 437 (54 USPQ 3)). And, as the request system communicates with the data encryption/retrieval system an inherent or at least obvious means for sending data would be via a wireless network. The remote print system (figure 1) has an address as it resides on a network. Further, this address is "provided" to a user of the Choudhury et al. system as the user then uses the address for receiving messages to be printed (abstract). Therefore, it would have been obvious to one of ordinary skill apply the encryption method disclosed by Maldy ('406, column 1, lines 5-47) to communications between a printer and a server in order to prevent illicit copying of confidential messages intended for printing ('406, column 1, lines 10-16; '074, column 1, lines 9-32 and column 2, lines 15-47; column 4, lines 31-42).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Keronen et al. disclose a public/private key generator that provides a public key to a user for input into a computer
- Davis et al. teach secure printing by providing a user with a key for the encryption of data that is to be printed at a printing node
- Mazzagatte et al. secure printing by encrypting data to be printed and requiring a receiver to provide a decrypting data for decrypting the data such that it can be printed
- Debry teaches online certification of a device (e.g. printer) and a device key

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Art Unit: 3621

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

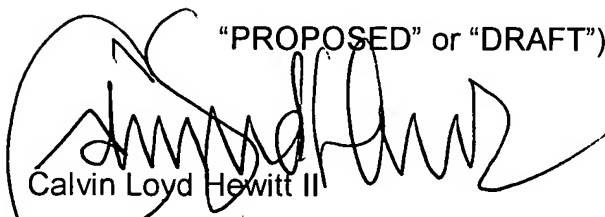
or faxed to:

(571) 273-8300 (for formal communications intended for entry and
after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")



Calvin Loyd Hewitt II

July 22, 2005